

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 53-124.

The following claims are *independent*: 53, 77 and 101.

The following claims have previously been *cancelled* without prejudice or disclaimer: 1-53.

Please *amend* claims 53, 74, 77, 98, 101 and 122 ; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 101

The Office Action has rejected claims 101-124 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant respectfully traverses this rejection. Applicant submits that there is no test for non-statutory subject matter that subjectively precludes the aforementioned claims. MPEP § 2106, Section IV, states “claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection.” MPEP § 2106 also discusses “[w]hile abstract

ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be.”

Applicant submits that the elements recited in the claims are, in fact, directed to statutory subject matter and do not fall within the recognized Judicial Exceptions as merely abstract ideas (such as mathematical algorithms), natural phenomena, and/or laws of nature. Though Applicant respectfully traverses the Examiner’s rejection and reserves the right to argue patentability of the claims in their original form at a later time, Applicant has amended independent claim 101 based on the Examiner’s suggested language (See, Office Action, page 3) to provide clarification and/or to better track business practices. Claim 101 is a “processor readable medium storing processor readable instructions” and recites “processor readable instructions are issuable by a processor for...” Applicant submits claims 101, and 102-124 (which depend directly or indirectly from independent claim 101), are directed to statutory subject matter for at least the reasons discussed above. Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific explanation describing how claim 101 is allegedly directed to non-statutory subject matter. Accordingly, for at least these reasons, Applicant submits that claims 101-124 are directed to statutory subject matter and withdrawal of this ground of rejections is requested.

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 53-67, 74-91, 98-115 and 122-124 under 35 U.S.C. § 103(a) as being unpatentable over Tawil, US Patent No. 5,519,607 (hereinafter “Tawil”), and in further view of Campbell, US Patent No. 6,208,974 (hereinafter “Campbell”). Claims 68-

69, 92-93 and 116-117 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Tawil and Campbell, in further view of DeBruin-Ashton, US Patent No. 6,014,629 (hereinafter “DeBruin-Ashton”). Applicant respectfully traverses the rejections and submits that a *prima facie* showing of obviousness has not been made and that the applied references, taken alone or in combination, fail to discuss or render obvious every element of each pending claim.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicant submits that the rejections in the pending Office Action do not establish each of these requirements. More specifically, Applicant submits that, by over-generalizing the applied references, the rejections in the Office Action do not establish at least either of the first two elements of a *prima facie* case of obviousness.

Independent claim 53 recites, *inter alia*:

53. (Currently Amended) A computer-system implemented method for providing a user with a customized healthcare services insurance package, comprising:

...
receiving a selection of a healthcare services panel comprising at least one of the healthcare service providers and a user-defined co-pay amount selected from a provider co-pay range
...

Applicant submits that the applied references, taken alone or in combination, do not discuss or render obvious at least these elements recited in independent claim 53. The

pending rejection alleges Campbell discusses "a method wherein co-payment information for a healthcare provider is used to help the user...(col. 23, lines 43-col.25, line 24; Figures 17-19--different plans offer different discounts/copays for the services...." (See, Office Action pages 10-11).

Applicant respectfully traverses and submits that Tawil and Campbell taken alone or in combination do not discuss or render obvious the claimed elements as recited in independent claim 53. Applicant respectfully disagrees with the Examiner's characterization of Tawil and Campbell. More specifically, Applicant submits that Campbell's system does not disclose at least the claimed element of "receiving ... user-defined co-pay amount selected from a provider co-pay range...", as recited in amended claim 53. Instead, Applicant submits that Campbell displays pre-determined fees associated with a selected wellness plan. For example, Campbell discusses "When the user chooses the 'select plan' button ... the right portion 1908 of the window shows a number of text boxes (1910-1914) for displaying fees associated with the plan type and level ... These values are assigned to the wellness plan when the plan is created at the central facility" (See, Campbell, Column 24, lines 10-23).

Furthermore, Applicant submits that Tawil fails to remedy the deficiencies identified above in Campbell. Instead, Tawil discusses "a list of providers available to perform the designated procedure, and each provider's charge for performing the designated procedure" (See, Tawil, Abstract). Tawil also discusses "the listed price in the database 10 can be a price recently charged by the provider. For example, the listed price can be the price charged by a provider on the most recent insurance claim" (Emphasis added) (See, Tawil, Column 2, lines 60-63).

In summary, Applicant submits that neither Campbell's pre-determined "displayed fees" nor Tawil's displayed previous doctor charges discuss or render obvious a "user-defined copay", as claimed, let alone at least "receiving a second selection of a user-defined copay amount from a selectable co-pay range for the one or more providers", as recited in amended independent claim 1.

The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added]. Applicant submits that the pending rejection has failed to consider "every limitation in the claim" and "[a]ll words in [the] claim" in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s).

Accordingly, Applicant submits that a *prima facie* showing of obviousness has not been put forth and respectfully requests reconsideration and withdrawal of this basis of rejection. Should the Examiner maintain the rejection, Applicant respectfully requests additional clarification as to how and specifically why the Examiner believes Tawil or Campbell is allegedly analogous to the claimed "receiving a selection of a healthcare services panel comprising at least one of the healthcare service providers and a user-defined co-pay amount selected from a provider co-pay range," as recited in independent claim 53.

Although of different scope than claim 53, Applicant submits that claim 77 is patentable over Tawil in view of Campbell, taken alone or in combination, for at least similar reasons as discussed above identifying deficiencies in the applied references with regard to independent claim 53. For example, independent claim 77 recites, *inter alia*, "...receiving a

selection of a healthcare services panel comprising at least one of the healthcare service providers and a user-defined co-pay amount selected from a provider co-pay range....” Applicant respectfully submits that at least these claim elements from independent claim 77 are not discussed or rendered obvious by Tawil, or by Campbell, taken alone or in combination, for at least the reasons discussed above. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection.

Although of different scope than claim 53, Applicant submits that claim 101 is patentable over Tawil in view of Campbell, taken alone or in combination, for at least similar reasons as discussed above identifying deficiencies in the applied references with regard to independent claim 53. For example, independent claim 101 recites, *inter alia*, “...receiving a selection of a healthcare services panel comprising at least one of the healthcare service providers and a user-defined co-pay amount selected from a provider co-pay range....” Applicant respectfully submits that at least these claim elements from independent claim 101 are not discussed or rendered obvious by Tawil, or by Campbell, taken alone or in combination, for at least the reasons discussed above. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection.

Furthermore, Applicant submits that claims 54-67, 74-76, 78-91, 102-115 122-124, which depend directly or indirectly from independent claims 53, 77 and 101, respectively are also not discussed or rendered obvious by Tawil and/or Campbell, taken alone or in combination, for at least similar reasons as those discussed above identifying deficiencies in the applied references with regard to the independent claims. Similarly, Applicant submits that claims 68-69, 92-93, and 116-117, which depend directly or indirectly from independent claims 53, 77 and 101, respectively are also not discussed or rendered obvious by Tawil,

Campbell and/or DeBruin-Ashton, taken alone or in combination, for at least similar reasons as those discussed above identifying deficiencies in the applied references with regard to the independent claims. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 53-124, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art and reserves the opportunity to more particularly traverse, remark and distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to an Office Action objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Office Action objection and/or rejection as to any other claim element(s),

any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17231-004US1. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17231-004US1.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

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Respectfully submitted,
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